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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,576	12/22/2000	Steven G. Smarsh	TRUTECH-P-30	3553

7590 03/09/2006  
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EXAMINER
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MORGAN, EILEEN P

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/720,576

**Applicant(s)**

SMARSH ET AL.

**Examiner**

Eileen P. Morgan

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-11 is/are pending in the application.
- 4a) Of the above claim(s) 1,2,9 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3,4,6-8 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**  
***Specification***

1. The substitute specification filed 2-13-06 has not been entered because it does not conform to 37 CFR 1.125(b) and (c) because: no marked up version has been received, as stated on page 6 of Applicant's remarks.
2. The amendment filed 10-15-04, 12-16-05, & 2-13-06 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the addition that the 'blade can be dressed by the dresser roller' (10-15-04). On 12-16-05, Applicant amended the independent claims to include that the computer program will 'select a scripted computer program'. This is unclear and not supported by the specification. On 2-13-05, Applicant amended the independent claims to include an additional 'means for displaying....' as if the dressing and grinding processes could be carried out simultaneously. This is impossible and is new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

3. The disclosure is objected to because of the following informalities: The specification does not clearly describe how the claimed invention works. Namely, how a 'new program is written'. The computer program is initially written and based on inputted values, the grinding apparatus performs a given process, but this is not writing a new program. There is insufficient description and method steps that define this function and how it is obtained. The phrase 'writes a new program' is used throughout the specification. For instance, on page 7 of the specification, it states. 'Disclosed is a

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computer controlled grinding and dressing machine which can write (nearly instantaneously by the operator) its own computer programs....' This is confusing in itself. Does the operator write the program or the machine? It further states ...'WITH INPUT OF SPECIFIC DATA'. Thus, the computer controlled machine is not actually 'writing a new program' but taking data input to adjust a 'pre-written program.'

Appropriate correction is required.

### **Claim Rejections - 35 USC § 112**

4.. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3,4,6-8,11 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support for dressing the blade which is a claimed alternative and this is deemed new matter. On 12-16-05, Applicant amended the independent claims to includes that the computer program will 'select a scripted computer program'. This is unclear and not supported by the specification. On 2-13-05, Applicant amended the independent claims to include an additional 'means for

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displaying.....' as if the dressing and grinding processes could be carried out simultaneously. This is impossible and is new matter.

5. Claims 3,4,6-8,11 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is no support for dressing the blade which is a claimed alternative and this is deemed new matter. On 12-16-05, Applicant amended the independent claims to includes that the computer program will 'select a scripted computer program'. This is unclear and not supported by the specification. On 2-13-05, Applicant amended the independent claims to include an additional 'means for displaying.....' as if the dressing and grinding processes could be carried out simultaneously. This is impossible and is new matter.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 3,4,6-8, 11 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3, there is no support for dressing the blade which is a claimed in the alternative and this is deemed new matter. Line 5, 'and grind a workpiece' is unclear. What does this refer to? Lines 11-12 are totally unclear and do not make sense. What are certain 'characters'? What are the numerical algorithms for? How do these algorithms and computer programs 'automatically be programmed'? It doesn't make sense that a 'computer program' is 'automatically programmed'. Also, the addition of lines 13-21 are unclear and unsupported by the specification. Applicant is now claiming a simultaneous operation of dressing AND grinding which is impossible. Are there two 'means for displaying'? Are there two computer screens? Two monitors? Lines 18-21 have similar problems as lines 11-12. Line 25, states a 'grinding operation' but a 'dressing operation' is recited in the preamble. Line 28, 'and grind' is unclear. This is not part of the preamble or the claimed operation and further this machine does not dress and grind at the same time. Last line what does 'and a workpiece' refer to? This is unclear. The addition of 'means for setting two grinding axes' and 'means for initiating a grinding operation' are unclear. What grinding axes? Of the grinding wheel during dressing? Or of the dressing wheel during dressing? What does initiating 'coolant' or 'cycles' mean? Coolant of what? Cycles of what? This is totally unclear. Claim 6 has identical problems as Claim 3. Claim 11 is totally unclear and does not make sense. Does the monitor select an icon? Again, this claim recites both, grinding and dressing, making this unclear and impossible. Lines 7-9 have the same problems as lines 11-12 of claim 1. Line 11, 'the process of grinding' is unclear. This is a 'dressing operation'. The addition of 'means for setting two grinding axes' and 'means for initiating a grinding

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operation' are unclear. What grinding axes? Of the grinding wheel during dressing? Or of the dressing wheel during dressing? What does initiating 'coolant' or 'cycles' mean? Coolant of what? Cycles of what? Lines 18-19 are repetitive of lines 7-9 and are not understood. What is the previous computer program?

### **Claim Rejections - 35 USC § 102**

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language.

9. Claims 3,4,6-8, 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Maack-5,766,057.

Maack discloses a centerless grinding machine with wheel dressers, wherein the dressing and grinding processes are carried out by a CNC or PLC (15) which has input means, display means, and compilation means for carrying out intended program based

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on the input, which is a 'scripted' program as broadly recited, dependent on input parameter.

### ***Response to Arguments***

Applicant's arguments filed 2-13-06 have been fully considered but they are not persuasive. Applicant alleges that the 112, 1<sup>st</sup> and 2<sup>nd</sup> paragraph rejections were overcome by the amendment. However, the amendment merely adds additional confusing language and does not overcome the previous rejections, nor were the rejections even addressed. For instance, there is a new matter rejection regarding 'dressing the blade' which has no support in the specification. This, again, was neither taken out or addressed. In addition, 'selecting a scripted program' is new matter and not selected by the specification. Applicant merely states that the amendment overcomes the Maack patent but gives no supporting arguments that this is true.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen P Morgan whose telephone number is 571.272.4488. The examiner can normally be reached on Tuesday-Thursday (Office), Friday (Work at home).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571.272.4485. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EM  
March 6, 2006



EILEEN P. MORGAN  
PRIMARY EXAMINER